

Remarks

The Examiner has mis-interpreted MPEP 2106 IIC to create new patent law requiring the recitation of structure in claim elements and also to interpret various claim language as comprising intended use language other than the “adapted to”, “wherein” and “whereby” clauses indicated in MPEP 2106 II, C. This is done without citation of governing legal authority.

The patent laws do not require inventors to disclose specific structure for functional electrical components that are reasonably understood by those of skill in the art, e.g., Personalized Media Communications, L.L.C., Appellant, v. ITC 1998 WL 34113331, 4, PPG Indus. v. Guardian Indus. Corp 75 F.3d 1558, 1562, 37 USPQ2d 1618, 1622 (Fed. Cir. 1996) (a claim complies with the definiteness requirement if those of ordinary skill understand what is claimed in light of the specification); Miles Labs., Inc. v. Shandon Inc., 997 F. 2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (same), cert. denied, 510 U. S. 1100 (1994). The test for adequacy of claim language is found in 35 USC Section 112. Specifically, paragraph 2 requires that the claims, read in light of the specification, distinctly point out and claim the invention such that those of ordinary skill could determine whether their systems are within the scope of the claims (“specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention”). In the electrical arts, the common and accepted method of describing and depicting systems is in terms of generic “black boxes” representing the functional electrical components necessary to implement the system. These “black boxes” denote any number of electrical structures that may be used to achieve the desired electrical function. The selection of a particular electrical structure or circuit is left to the system designer. Because systems in the electrical arts are typically described and depicted in this manner, it is also the proper and accepted method by which such systems are claimed in electrical art patents. See Miles Labs., Inc., 997 F. 2d at 875, 27 USPQ2d at 1126 (“The degree of precision necessary for adequate claims is a function of the nature of the subject matter.”). Here the system of claim 1 recites “a first database for maintaining product information”, “a data processor for receiving product information and for updating said first database” and “an interface processor for communicating updated product price information”. These are items well known to those of ordinary skill in the art and the inventors do not claim that their invention resides in these components themselves but rather in the claimed manner of their operation and use. The fact that the inventors do not intend to limit the structure of the components within the claimed system does not invalidate the claims. The claim limitations recited are not optional and does limit the claim scope. Anyone of ordinary skill in the art, examining the specification and claims of the

Application, would easily have understood the scope and function of each of the claimed elements and their inter-operation.

In addition the Examiner fails to identify any “adapted to”, “wherein” and “whereby” clauses in the independent claims or provide any other reasonable justification for the unsupported allegation that these claims are replete with intended use phrases. The Examiner states, for example, that “a data processor for receiving product information” illustrates such an intended use. However, the full limitation is “a data processor for receiving product information and for updating said first database information to incorporate received product information including product sales data and contract sales terms of a vendor in response to detection of matching records between said received product information and said first database information”. Clearly, this is a claim limitation that anyone of ordinary skill in the art can readily comprehend contrary to the Examiner’s assertion. The Examiner is reminded by MPEP 2106 II, C in evaluating the scope of a claim that “every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered, See, e.g., Diamond v. Diehr, 450 U.S. at 188-89, 209 USPQ at 9”.

Applicant believes the claims fully distinguish over the recited reference for the reasons given in the Appeal Brief.

Accordingly it is respectfully submitted that the rejection of Claims 1– 26 should be reversed.

Respectfully submitted,
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